

\* \* \* COMMUNICATION RESULT REPORT ( AUG. 6. 2004 5:21PM ) \* \* \*

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## TELEFAX

Date: August 6, 2004

Total pages: 7 (including Fax  
Cover Sheet)

To: US PTO

Telephone:

Telefax: 703-872-9306

From: Patrea L. Pabst

Telephone: 404-879-2151

Telefax: 404-879-2160

Our Docket No. RPMS 101 CON (3)

Client/Matter No. 078230/18

Your Docket No.

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## MESSAGE:

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: David William Holden

Serial No.: 09/714,602

Art Unit: 1636

Filed: November 16, 2000

Examiner: G. Leffers

For: IDENTIFICATION OF GENES

Docketed for \_\_\_\_\_  
By: AS  
Date: 8/16/04

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**MESSAGE:**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**Applicant:** David William Holden

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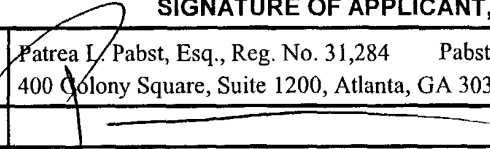
**Examiner:** G. Leffers

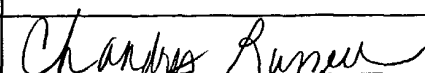
**For:** *IDENTIFICATION OF GENES*

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<b>TRANSMITTAL FORM</b>  <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/714,601 <b>2</b>
	Filing Date	November 16, 2000
	First Named Inventor	David William Holden
	Art Unit	1636
	Examiner Name	G. Leffers
Total Number of Pages in This Submission	Attorney Docket Number	RPMS 101 CON 3

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks <span style="border: 1px solid black; display: inline-block; width: 100px; height: 1.2em; vertical-align: middle;"></span>		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Patrea L. Pabst, Esq., Reg. No. 31,284 Pabst Patent Group LLP 400 Colony Square, Suite 1200, Atlanta, GA 30361
Signature	
Date	August 6, 2004

CERTIFICATE OF TRANSMISSION/MAILING	
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.	
Typed or printed name	Chandra Russell
Signature	
Date	August 6, 2004

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT

(\$ 0

## Complete if Known

Application Number	09/714,602
Filing Date	November 16, 2000
First Named Inventor	David William Holden
Examiner Name	G. Leffers
Art Unit	1636
Attorney Docket No.	RPMS 101 CON 3

## METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None
☒ Deposit Account:
 Deposit  
Account  
Number  
Deposit  
Account  
Name

50-3129

Pabst Patent Group LLP

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit any overpayments☒ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

## 1. BASIC FILING FEE

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	
SUBTOTAL (1)			(\$ 0

## 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
21	-31 = 0	X	0
1	-3** =	X	0
Multiple Dependent			

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent
SUBTOTAL (2)		

(\$ 0

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

## 3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 420	2252 210	Extension for reply within second month	
1253 950	2253 475	Extension for reply within third month	
1254 1,480	2254 740	Extension for reply within fourth month	
1255 2,010	2255 1,005	Extension for reply within fifth month	
1401 330	2401 165	Notice of Appeal	
1402 330	2402 165	Filing a brief in support of an appeal	
1403 290	2403 145	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,330	2453 665	Petition to revive - unintentional	
1501 1,330	2501 665	Utility issue fee (or reissue)	
1502 480	2502 240	Design issue fee	
1503 640	2503 320	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 770	2809 385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 770	2810 385	For each additional invention to be examined (37 CFR 1.129(b))	
1801 770	2801 385	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 0

## SUBMITTED BY

Name (Print/Type)

Patrea L. Pabst

Registration No.  
(Attorney/Agent)

31,284

(Complete if applicable)

Telephone (404) 879-2151

Signature

Date

August 6, 2004

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SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

RPMS 101 CON(3)

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: David William Holden

Serial No.: 09/714,602

Art Unit: 1636

Filed: November 16, 2000

Examiner: G. Leffers

For: IDENTIFICATION OF GENES

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REQUEST FOR RECONSIDERATION OF PETITION  
FOR SUPERVISORY REVIEW BY THE COMMISSIONER**

Sir:

Responsive to the Office Action mailed on February 9, 2004, and further to the decision on Petition dated August 6, 2004, please consider the following petition. It is believed that no fee is required with this submission. However, should a fee be required, the Commissioner is hereby authorized to charge the fee of \$130 to Deposit Account No. 50-1868.

Applicant respectfully requests that the Commissioner exercise supervisory authority in the prosecution of the pending application, as allowed under 37 C.F.R. 1.181(a)(3). Specifically, the Applicant requests that the Commissioner review the Examiner's assertions for denying applicant's right of priority to parent applications 09/201,945 and 08/637,759. With regard to the issues raised by the examiner relating to the 09/201,945 and 08/637,759 priority applications, the applicant disagrees with the examiner's assertions. *This application is a continuation of*

**REQUEST FOR RECONSIDERATION OF PETITION  
FOR SUPERVISORY REVIEW BY THE COMMISSIONER**

*09/201,945 and 08/637,759 filed under 35 U.S.C. 120 – accordingly, the specification and claims of the priority applications is identical to the specification and claims of the present application as originally filed. While the examiner can question the enablement of the specification of the claims on appeal, he cannot deny priority since the specifications are identical.*

Each of 09/201,945 and 08/637,759, as well as the present application, satisfy the priority, written description, enablement and clarity requirements, as discussed in more detail below. The claims are drawn to identifying a mutant microorganism having a reduced adaptation to a particular environment. It is not important to the operation of the method how the mutant microorganisms are generated provided that each mutant microorganism originally contains a different marker sequence which can be used to track the fate of the mutant microorganism in the particular environment. The term “marker sequence” is a DNA sequence that marks the mutant (and each different mutant is marked with a different marker sequence in order to follow the fate of each mutant in the particular environment). A plurality of mutants are introduced into a particular environment and allowed to grow, if they are able to do so. The microorganisms are retrieved from the environment; and individual mutants are selected having a reduced capacity to proliferate in the particular environment. This selection is based upon comparing marker sequences, if any, in the nucleic acid present in the retrieved microorganisms to the different marker sequences present in the microorganisms originally introduced into the environment.

**REQUEST FOR RECONSIDERATION OF PETITION  
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The specification states "it will be appreciated that although transposons are convenient for insertionally inactivating a gene, any other known method, or method developed in the future may be used" at page 11, lines 10-12. This statement, for example, is clear support for making mutants using any suitable means, and not just through the use of transposons. Furthermore, page 11, lines 12 to 17 discuss "insertion-duplication mutagenesis"; page 11, lines 19 to 26 refer to the use of DNA fragments or plasmids; and page 11, lines 28 to 30 refer to the use of Ty elements and ribosomal DNA in yeast. It is perfectly clear that the claimed methods are not limited to the use of transposons and transposon-like elements.

The Commissioner is respectfully referred to page 12, lines 3 and 4, wherein the purpose of introducing a marker sequence into the genome of the microorganism such that "each mutant contains a different marker sequence." This is exactly what is in claim 57, step (a):

"(a) providing a plurality of mutant microorganisms wherein each mutant contains a different marker sequence."

The specification, as indicated above, makes it plain that such mutants may be made using any suitable means, and not just through the use of transposons.

Step (d) requires the comparison of the unique tag sequences (i.e. the different marker sequences, if any) in surviving microorganisms with the tags of the plurality of mutant microorganisms introduced into the particular environment (i.e. those of step (a) of the method). It is those individual mutants having a reduced capacity to proliferate in the particular

U.S.S.N. 09/714,602

Filed: November 16, 2000


**REQUEST FOR RECONSIDERATION OF PETITION  
FOR SUPERVISORY REVIEW BY THE COMMISSIONER**

environment which are selected. This is described at page 4, lines 20 and 21, where it is noted that the method uses negative selection to identify microorganisms with a reduced capacity to proliferate in the environment. The present claims are properly based on subject matter present in the original applications.

In denying applicant's claim to priority, the examiner has requested a new **oath/declaration** omitting the priority claim. This is clearly improper since the application is fully entitled to priority and the examiner does not have the right to refuse applicant the right to claim priority in a continuation application filed under 35 U.S.C. 120.

Applicant respectfully requests consideration of priority for the present application and claims to parent applications 09/201,945 and 08/637,759.

Respectfully submitted,

  
Patrea L. Pabst  
Reg. No. 31,284

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